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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,998

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Robin D. Clark

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EXAMINER

DAVIS, ZINNA NORTHINGTON

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

03/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,998	Applicant(s) CLARK ET AL.	
	Examiner Zinna Northington Davis	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 19-29 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 and 30-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 19-21, 24, 26, 27 and 33 is/are rejected.
- 7) ☒ Claim(s) 22, 23, 25, 28, 29, 34 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

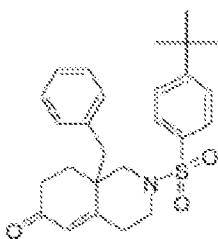
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/08/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 and 19-35 are pending. Claims 16-18 have been cancelled.
2. In the response filed December 15, 2008, Applicants have Group I, claims 1-15, 19-29, and 33-35, with traverse. Applicants also identify compound 26 of Table I as the preferred species. The compound is depicted below.



wherein L^2 , L^3 , L^4 , a and b are each a bond, R^1 is absent, R^2 is (=O), R^3 is benzyl, X is $-S(O)_2-$, A is phenyl and R^{40} is t-butyl. Claims readable on the elected species are claims 1-12 and 19-35.

3. Based upon the election of the Example 2, claims 1-8, 19-29, and 33-35 are drawn to the elected invention.
4. Claims 9-15 and 30-32 are withdrawn from consideration. These claims have not been canceled.
- 5.

Response to Applicants Remarks about The Improper Restriction Requirement

Applicants state the traversal is on the basis that the Patent Office has not established that it would pose an undue burden to search the entire scope of the claims.

It is the Examiner's position that:

- The compounds of formula I are drawn to independent and patentably distinct subject matter.

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- A prior art reference, which anticipates one member such as R⁴ is represents phenyl under 35 U.S.C. 102, would not render obvious another member such as –S(O)₂-cyclohexyl under 35 U.S.C. 103. Accordingly, the ring systems and the radicals are independent and patentably distinct.
- Under MPEP 806.05(h), the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. In this instance, the product as claimed can be used in a materially different process of using that product.
- There is an undue burden is to search the entire scope of claims when multiple inventions are claimed.
- The requirement is still deemed proper.
- The requirement is therefore made FINAL.

6. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

7. Claims 1-8, 19-29, and 33-35 are Markush claims which are generic to the elected invention. The Markush type claim will be examined fully with respect to the

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elected species and further to the extent necessary to determine patentability. See MPEP 803.02.

8. Claims 1-8, 19-29, and 33-35 are objected on the grounds that the claims are drawn to an improper Markush group. In re Harnisch, 206 USPQ 300, states that a unity of invention exists where compounds included within a Markush group(1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility. In the instant case, the claimed subject matter does not share a substantial structural feature disclosed as being essential to that utility.

9. The requirement for a proper Markush claim is that it includes only substances that in their physical, chemical and physiological characteristics are functionally equivalent. The members of the instant Markush groups possess widely different, physical and chemical properties. The compounds are not considered functionally equivalent and are so diverse that they demonstrate dissimilar and unrelated properties. The mere fact that there is structural similarity in pharmaceutical agents is not in itself reason to render all the embodiments functionally equivalent.

10. The improper Markush groups are L^2 , L^3 , L^4 , R^1 , R^2 , R^3 , R^4 , X, and A.

11. The elected compound has been examined and found to be allowable. The search has been extended beyond the elected compound.

12. The examined subject matter is as follows:

A compound of formula I wherein L^2 and L^3 are each a bond; L^4 is a bond and unsubstituted alkylene; R^1 is absent; R^2 is (=O); R^3 is substituted alkyl; X is a bond and

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-S(O)₂-; and A is phenyl. The radicals not defined herein are defined according to claim

1. Amending the claims to the examined subject matter would overcome the improper Markush rejection.

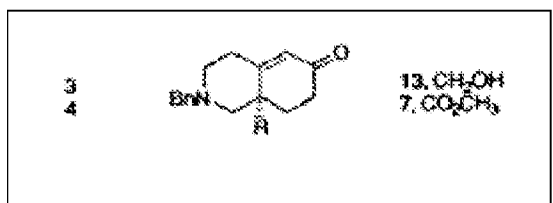
13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-8, 19-21, 24, 26, 27, and 33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by MaGee et al (Reference AO, cited by Applicants).

The instantly claimed compounds are disclosed. At pages 2551, Table I, see the compounds. The compounds are depicted below:



The claims are fully met when X, L², and L³ are each a bond; L⁴ is an unsubstituted alkyl; R¹ is absent; R² is (=O); R³ is substituted alkyl; and A is phenyl.

15. The Information Disclosure Statement filed March 8, 2007 has been considered.

16. Reference U is cited to show the state of the art.

17. Claims 22, 23, 25, 28, 29, 34, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna Northington Davis whose telephone number is 571-272-0682.

19. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Zinna Northington Davis/
Zinna Northington Davis
Primary Examiner
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